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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB AUG. 11, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Melamine Chemicals, Inc.*

Serial Nos. 74/406,483; 74/406,485; 74/546,552; and
74/546,554

Theodore A. Breiner of Breiner & Breiner for applicant.

Carolyn C. Gray, Trademark Examining Attorney, Law Office
101 (Chris Wells, Managing Attorney).

Before Quinn, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications have been filed by Melamine Chemicals,
Inc. to register the mark MELAMINE CHEMICALS, INC. and the
mark shown below

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for "chemicals, namely, melamine"¹ and "providing technical consultation services in the field of melamine."² In each application, applicant claims that the mark sought to be registered has acquired distinctiveness as provided by Section 2(f) of the Trademark Act.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that the term sought to be registered is merely descriptive of the recited goods and services, and has not acquired distinctiveness. It is the Examining Attorney's position that the term, as used in connection with the goods and services, is generic and hence incapable of functioning as a mark, and that even if it is capable of functioning as a mark, the evidence of distinctiveness submitted by applicant is insufficient to establish that the designation has acquired distinctiveness as a mark.³

¹ Respectively, application serial nos. 74/406,483, filed June 28, 1993, alleging dates of first use of 1968, and 74/546,552, filed July 7, 1994, alleging dates of first use of 1988.

² Respectively, application serial nos. 74/546,554, filed July 7, 1994, alleging dates of first use of 1968, and 74/406,485, filed June 28, 1993, alleging dates of first use of 1988.

³ Applicant contends that genericness is not the basis of the refusal and that, therefore, the Examining Attorney's arguments directed to genericness are "improper and prejudicial." This view is not well taken. Early on in the lengthy prosecution of these applications, the Examining Attorney, although initially refusing registration on the basis of mere descriptiveness, also indicated that the applied-for mark appeared to be generic. Thus, according to the Examining Attorney's Office actions, she could not recommend an amendment to proceed under Section 2(f) of the Act.

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney have filed briefs in these consolidated appeals,⁴ and both were present at an oral hearing held before the Board.

In support of the refusal, the Examining Attorney points to the dictionary evidence showing the readily understood meanings of the individual words in MELAMINE CHEMICALS, INC. The Examining Attorney concludes that the composite designation is not registrable.

Applicant argues that its mark sought to be registered is not merely descriptive, and certainly not generic, and that it has established a prima facie case of acquired distinctiveness. Applicant maintains that the declarations of record are entitled to more evidentiary weight than are the dictionary definitions.

Applicant has furnished the declaration of Frederic Huber, applicant's president and chief executive officer. Mr. Huber begins by explaining that melamine is a specialty

Accordingly, the Board finds that the issues identified above are properly before it for consideration. Given the remands and supplemental briefs in this case, applicant has ample opportunities to address these issues. Having said this, we frankly acknowledge that some of the Examining Attorney's actions in the involved applications hardly present a model of examination.

⁴ The Examining Attorney's brief is accompanied by dictionary definitions of which the Board may properly take judicial notice. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports*

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chemical with important uses in adhesives, molded plastics, and paints, and as a fire retardant. Melamine is generally sold to manufacturers in those industries in large quantities varying in size from 20 metric tons to 500 metric tons. Due to the nature of the melamine product and the target customers for melamine, Mr. Huber explains that applicant does not have a large advertising budget. Mr. Huber goes on to state, in pertinent part, that applicant was formed in 1968 and is the third largest manufacturer of melamine among the ten producers of melamine throughout the world. According to Mr. Huber, applicant has been using the marks sought to be registered for its goods and services since 1968, and that this use has been continuous and substantially exclusive, pointing out that no other manufacturer of melamine has used the term MELAMINE CHEMICALS, INC. to designate its goods or services. Mr. Huber asserts that MELAMINE CHEMICALS, INC. is not a generic name for applicant's goods or services, but rather is a trademark/service mark recognized in the industry and by applicant's customers as indicating source or origin in applicant. Mr. Huber states that applicant's sales of

Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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melamine for the period 1990-1995 are in excess of \$231.5 million.

Applicant also has submitted form declarations from seventeen individuals who are employed by companies which purchase melamine from applicant. The declarants are either officers or managers of these companies. After setting forth the length of time that their companies have purchased melamine from applicant, the declarants go on to make the following pertinent statements:

The name MELAMINE CHEMICALS[,] INC. to me designates [applicant's] products and services and distinguishes them from those of others.

The name MELAMINE CHEMICALS, INC. to me designates a single source of origin of melamine and the custom supply of melamine and providing technical services in the field of melamine.

To my knowledge, no other manufacturer or seller of melamine has used or uses the name MELAMINE CHEMICALS, INC. to designate its products and services.

The name MELAMINE CHEMICALS, INC. to me is not a generic designation for melamine or the services of the custom supply of melamine and consulting in the field of melamine.

Applicant further submitted a page from the *Official Gazette*, contending that marks more descriptive than applicant's have been approved for publication. Applicant also has relied upon two Canadian registrations which have

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issued for the marks sought to be registered herein, and applicant's prior United States registration of MELAMINE (stylized) for the same goods and services as those here.⁵

The principal issues to be determined in this case are (1) whether the designation MELAMINE CHEMICALS, INC. is generic when used in connection with chemicals, namely melamine, and technical consultation services in the field of melamine; (2) whether the designation is merely descriptive of such goods or services within the meaning of Section 2(e)(1); and (3) if we find that the designation is merely descriptive but not generic, whether it has acquired distinctiveness.

We turn first to the issues of whether MELAMINE CHEMICALS, INC. is generic, and whether it is merely descriptive, as used in the context of melamine chemicals and technical consulting services in the field of melamine chemicals. A mark is merely descriptive if, as used in connection with the goods or services in question, it describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, feature, etc. thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the goods or services. See:

⁵ Registration No. 2,022,726, issued December 17, 1996, pursuant to the provisions of Section 2(f). The registration also

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In re Abcor Development Corp., 588 USPQ 811, 200 USPQ 215 (CCPA 1978); In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB 1992); and In re American Screen Process Equipment Co., 175 USPQ 561 (TTAB 1972). A mark is a generic name if it refers to the class or category of goods or services on or in connection with which it is used. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Act; Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., supra. The Patent and Trademark Office has the burden of establishing that a mark is generic and thus unregistrable. In re Merrill Lynch, Pierce, Fenner and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). As to acquired distinctiveness, applicant has the burden of proof to establish a prima facie case of acquired distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony,

includes a disclaimer of the word "melamine."

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surveys, dictionaries, trade journals, newspapers, and other publications. In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). The Patent and Trademark Office may, in appropriate cases, satisfy its evidentiary burden by means of dictionary definitions showing that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987).

The words comprising applicant's mark have readily understood meanings as shown by the dictionary definitions. The term "melamine" is defined as "a white crystalline compound used to make melamine resins", and the term "chemical" is defined as "a substance produced by or used in a chemical process." The designation "Inc." is an abbreviation for "Incorporated."

We find that the present appeal falls squarely under a line of cases wherein similar issues have been before the Board. In re Paint Products Co., 8 USPQ2d 1863 (TTAB 1988) [PAINT PRODUCTS CO. for paints held unregistrable]; In re Industrial Relations Counselors, Inc., 224 USPQ 309 (TTAB 1984) [INDUSTRIAL RELATIONS COUNSELORS for educational services in the field of industrial relations held

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unregistrable]; In re The BOC Group, Inc., 223 USPQ 462 (TTAB 1984) [COMPUTER LEARNING CENTER for educational services held unregistrable]; and In re E. I. Kane, Inc., 221 USPQ 1203 (TTAB 1984) [OFFICE MOVERS, INC. for moving services held unregistrable]. We find that the Examining Attorney has satisfied her evidentiary burden here by showing that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." In re Gould Paper Corp., supra at 1111-12. There is nothing left for speculation or conjecture in the alleged trademark/service mark. In the present case, "the terms remain as generic in the compound as individually, and the compound thus created is itself generic." Id. Simply put, MELAMINE CHEMICALS, INC. is a name for melamine chemicals and services directly related thereto, rather than a mark identifying the source of the goods and services.

The fact that applicant has obtained two Canadian registrations of MELAMINE CHEMICALS, INC. (with the words "MELAMINE" and "CHEMICALS" disclaimed) is not persuasive of a different result here. This evidence is irrelevant inasmuch as the determination of genericness must be governed by the statute and legal principles of this country. Additionally, the *Official Gazette* excerpt and

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applicant's prior registration of MELAMINE (stylized) for the same goods and services as those here are of no moment.⁶

Each case must be decided on its own facts and, while uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's mark is registrable.

Micro Motion Inc. v. Danfoss A/S, 49 USPQ2d 1628, 1631 (TTAB 1998).

In finding that the designation MELAMINE CHEMICALS, INC. is incapable of identifying applicant's goods and services and distinguishing them from similar goods and services of others, we have considered, of course, all of the evidence touching on the public perception of this designation, including the evidence of acquired distinctiveness. In re Paint Products Co., supra. Applicant's evidence of acquired distinctiveness suggests that at least some purchasers view MELAMINE CHEMICALS, INC. as a trademark and/or service mark. Nonetheless, if the

⁶ In any event, we would point out that the United States' registration, while issued pursuant to Section 2(f), nevertheless includes a disclaimer of the word "melamine." See: In re Creative Goldsmiths of Washington, Inc., 229 USPQ 766, 768 (TTAB 1986) ["[W]e conclude that it is within the discretion of an Examining Attorney to require the disclaimer of **an unregistrable component (such as a common descriptive, or generic, name)** of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f)." (emphasis added)]. See also: *Trademark Manual of Examining Procedure*, §§ 1212.02(e) and 1213.02(b).

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evidence as a whole establishes--as it does to our satisfaction--that the term would be primarily perceived as a generic term, the recognition of the term as a trademark/service mark by some of applicant's customers must be deemed no more than a de facto secondary meaning that, in legal effect, can neither confer nor maintain trademark/service mark rights in the designation sought to be registered. See, e.g., *Kellogg Co. v. National Biscuit Co.*, 385 U.S. 111, 39 USPQ 296, 299 (1938); *J. Kohnstam, Ltd. v. Louis Marx & Co., Inc.*, 280 F.2d 437, 126 USPQ 362, 364 (CCPA 1960); and *Schulmerich Electronics, Inc. v. J. C. Deagan, Inc.*, 202 F.2d 772, 97 USPQ 141, 145-46 (CCPA 1953). See also: *McCarthy on Trademarks and Unfair Competition*, § 12:47 (4th ed. 1999).

We recognize that applicant's use dates back to 1968, and that applicant's sales figures would suggest that it has enjoyed a degree of success. This evidence, however, demonstrates only the popularity of applicant's goods and services, not that the relevant purchasers of such goods and services have come to view MELAMINE CHEMICALS, INC. as a source-identifying mark. The issue here is the achievement of acquired distinctiveness, of which applicant bears the burden of proof. In *re Andes Candies Inc.*, 478 F.2d 1264, 178 USPQ 156, 158 (CCPA 1973) ["Because of long

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use, large sales and advertising, it may be assumed that some persons might recognize a mark as identifying origin, but that alone is not enough."].

The form declarations of seventeen individuals, although entitled to probative weight, do not tip the scales in applicant's favor. The statements undoubtedly were prepared by counsel and, given applicant's mark, represent, at best, de facto recognition. For us, the unambiguously generic meaning of the words that make up applicant's mark is more convincing evidence of likely perception than the form declarations solicited and offered by applicant. In re Paint Products Co., supra.

Accordingly, even if the term MELAMINE CHEMICALS, INC. were found to be not generic, but merely descriptive, given the highly descriptive nature of the term, we would need to see a great deal more evidence than applicant has made of record in order to find that the term has become distinctive of applicant's melamine chemicals and related services. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. Yamaha Int'l. Corp. v. Hoshino Gakki Co., supra; and In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra. See also: Restatement (Third) of Unfair Competition (1993), § 13, comment e:

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The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness. Indeed, some designations may be incapable of acquiring distinctiveness.

Lastly, the fact that applicant may be the first or the only one using MELAMINE CHEMICALS, INC. in the field is not dispositive. In re Central Sprinkler Co., 49 USPQ2d 1194, 1199 (TTAB 1998).

Decision: The refusals to register are affirmed.

T. J. Quinn

C. E. Walters

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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